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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

BRANSTROM et al.

Appl. No. 08/711,961

Filed: September 6, 1996

For: BACTERIAL DELIVERY SYSTEM

Appeal No. 2001-1881

Art Unit: 1636

Examiner: I. Yucel

Atty. Docket No. 38644-175286

Customer No.

26694

PATENT TRADEMARK OFFICE

PETITION TO WITHDRAW ERRONEOUS NOTICE OF ABANDONMENT

U.S. Patent and Trademark Office
Mail Stop: Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

We received a Notice of Abandonment dated April 2, 2004 in the above-referenced application. The Notice indicated that the application was abandoned because a decision by the Board of Patent Appeals and Interferences was rendered on December 22, 2003 and the period for seeking court review of the decision had expired and there are no allowed claims. It is respectfully noted that a request for rehearing was timely filed on January 22, 2004, and a Denial of the Request was issued on March 1, 2004.

Accordingly, pursuant to 37 CFR 1.304, the time for further Appeal expires May 1, 2004.

Serial No. 08/711,961

A copy of the Request for Rehearing, along with the date stamped receipt therefore, and a copy of the Denial, are filed herewith in support of the above.

Withdrawal of the Notice of Abandonment and consideration of the Request for Continued Examination filed herewith are respectfully requested.

It is believed that no extension of time or fee is required in connection with this petition. However, if any fees are due, please charge Deposit Account No. 21-0380 and advise accordingly.

Respectfully submitted,

Dated: April 27, 2004

C. S. Hobbs
Ann S. Hobbs
Registration No. 36,830
VENABLE
Post Office Box 34385
Washington, D.C. 20043-9998
Telephone: (202) 344-4000

ASH/cc

117637

Venable Filing Number



Attorney, ~~MA~~: Ann S. Hobbs, Ph.D.

Ann S. Hobbs, Ph.D.

January 22, 2004

January 22, 2004

TM Official Gazette Date:

Atty. Docket No: 38644-175286

Re: Branstrom et al.,

Application No. 08/711,961

Patent No.:

Patent No.:

Trademark
Registration No:

Opposition/Cancellation No:

Filing Date: September 6, 1996

Issue Date: September 5, 1985

Trade Date: _____

Trademark Reg. No.

Atty. Docket No: 38644-175286 *TRADEMARK*
Re: Branstrom et al.,
Application No: 08/711,961 Filing Date: September 6, 1996
Patent No.: Issue Date:
Trademark: Trademark Reg. No:
Cancellation No:

The following items were received from Venable, Washington, D.C., by the U.S. Patent & Trademark Office:

U.S. PTO FEES ENCLOSED

<input type="checkbox"/>	Transmittal Letter	<input type="checkbox"/>	Filing Fee
<input type="checkbox"/>	Fee Transmittal Letter	<input type="checkbox"/>	Surcharge Fee
<input type="checkbox"/>	New U.S. Utility Application (pages of specification/claims)	<input type="checkbox"/>	Additional Claim Fee
<input type="checkbox"/>	Formal Drawings (10 sheets, Figs.)	<input type="checkbox"/>	Recordation/Indexing Fee
<input type="checkbox"/>	Invention Declaration	<input type="checkbox"/>	IDS Fee
<input type="checkbox"/>	U.S. National Stage Application of PCT Application	<input type="checkbox"/>	Extension Fee
<input type="checkbox"/>	Translation of International Application	<input type="checkbox"/>	Notice of Appeal Fee
<input type="checkbox"/>	New U.S. TM Application (specimens)	<input type="checkbox"/>	Brief on Appeal Fee
<input type="checkbox"/>	Rule 53(d) Continued Prosecution Application	<input type="checkbox"/>	Oral Hearing Request Fee
<input type="checkbox"/>	Substitute Specification	<input type="checkbox"/>	Petition Fee
<input type="checkbox"/>	Rule 53(b) Continuation or Divisional Application (attach copy of specification, claims, drawings & declaration)	<input type="checkbox"/>	Issue Fee
<input type="checkbox"/>	Priority Document-Cert. Copy of Appln.#: ; Country	<input type="checkbox"/>	Publication Fee
<input type="checkbox"/>	Date Filed:	<input type="checkbox"/>	Maintenance Fee
<input type="checkbox"/>	Request for Continued Examination (RCE) under 37 CFR 1.114	<input type="checkbox"/>	TM Statement of Use
<input checked="" type="checkbox"/>	Request for Reconsideration	<input type="checkbox"/>	8 Affidavit Fee
<input type="checkbox"/>	Application Data Sheet	<input type="checkbox"/>	8 and 15 Affidavit
<input type="checkbox"/>	Assignment w/Cover Sheet	<input type="checkbox"/>	TM Renewal Application Fee
<input type="checkbox"/>	IDS w/ PTO SB/08 a/k/a PTO Form-1449 (references)	<input type="checkbox"/>	Notice of Opposition Fee
<input type="checkbox"/>	Response	<input type="checkbox"/>	TM Extension of Time Fee
<input type="checkbox"/>	<input type="checkbox"/> Amendment/ <input type="checkbox"/> Preliminary Amendment	<input type="checkbox"/>	
<input type="checkbox"/>	Petition/Request for Extension of Time (one mo. ext.)	<input type="checkbox"/>	
<input type="checkbox"/>	Notice of Appeal	<input type="checkbox"/>	
<input type="checkbox"/>	Appeal Brief (<i>in triplicate</i>)	<input type="checkbox"/>	
<input type="checkbox"/>	<input type="checkbox"/> Reply Brief (<i>in triplicate</i>)/ <input type="checkbox"/> Request for Oral Hearing	<input type="checkbox"/>	
<input type="checkbox"/>	Confirmation of Hearing Petition	<input type="checkbox"/>	
<input type="checkbox"/>	Issue Fee Transmittal	<input type="checkbox"/>	
<input type="checkbox"/>	Certificate of Correction	<input type="checkbox"/>	
<input type="checkbox"/>	Maintenance Fee Transmittal	<input type="checkbox"/>	
<input type="checkbox"/>	Power of Attorney	<input type="checkbox"/>	
<input type="checkbox"/>	Response to Notice to File Missing Parts	<input type="checkbox"/>	
<input type="checkbox"/>	Response to Notice to File Missing Requirements	<input type="checkbox"/>	
<input type="checkbox"/>	Response to Restriction Requirement	<input type="checkbox"/>	
<input type="checkbox"/>	Petition to Revive	<input type="checkbox"/>	
<input type="checkbox"/>	Sequence Listing – CDR Enclosed? <input type="checkbox"/> Yes <input type="checkbox"/> No	<input type="checkbox"/>	
<input type="checkbox"/>	Status Inquiry	<input type="checkbox"/>	
<input type="checkbox"/>	Request for Non-Publication	<input type="checkbox"/>	
<input type="checkbox"/>	Request to Rescind Non-Publication Request	<input type="checkbox"/>	
<input checked="" type="checkbox"/>	Terminal Disclaimer	<input type="checkbox"/>	
<input type="checkbox"/>	TM Statement of Use	<input type="checkbox"/>	
<input type="checkbox"/>	Extension of Time (mo. ext.)	<input type="checkbox"/>	
<input type="checkbox"/>	Declaration Under 8	<input type="checkbox"/>	
<input type="checkbox"/>	Declaration Under 8 and 15	<input type="checkbox"/>	
<input type="checkbox"/>	TM Renewal Application	<input type="checkbox"/>	
<input type="checkbox"/>	Notice of Opposition (<i>Please list all documents in Other section</i>)	<input type="checkbox"/>	
<input type="checkbox"/>	Amendment to Alleged Use	<input type="checkbox"/>	
<input type="checkbox"/>	Other: (<i>Please describe below</i>)	<input type="checkbox"/>	

Total Fees Paid

Check Number Attached
Charge Deposit Account No. 22-0261*
 Yes No

***If the Deposit Account was used, was a copy of this form sent to Accounting?**



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

BRANSTROM et al.

Appl. No. 08/711,961

Filed: September 6, 1996

For: BACTERIAL DELIVERY SYSTEM

Appeal No. 2001-1881

Art Unit: 1636

Examiner: I. Yucel

Atty. Docket No. 38644-175286

Customer No.

26694

PATENT TRADEMARK OFFICE

REQUEST FOR RECONSIDERATION

U.S. Patent and Trademark Office
Mail Stop: U.S. Board of Patent Appeals and Interferences
2011 South Clark Place
Customer Window
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

Sir:

Applicants request reconsideration of the Decision on Appeal issued December 22, 2003, affirming the obviousness-type double patenting rejection over prior U.S. Patent No. 5,824,538. A Terminal Disclaimer was filed in the application on October 17, 2003, a copy of which is attached hereto. It is respectfully submitted that the Terminal Disclaimer overcomes the obviousness-type double patenting rejection. Accordingly, it is requested that the Board reverse the double patenting rejection and allow the patent to issue..

Serial No. 08/711,961

It is believed that no fees are required. However, if the Patent Office deems that any fees are necessary, authorization is hereby granted to charge any required fees

Deposit Account No. 22-0261

Respectfully submitted,



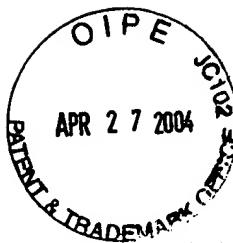
Ann S. Hobbs, Ph.D.
Registration No. 36,830

VENABLE
P.O. Box 34385
Washington, D.C. 20043-9998
Telephone: (202) 344-4800
Telefax: (202) 344-8300

ASH/cc

115 874

Venable Filing Number



Attorney/LA: Ann S. Hobbs

PTO Due Date: October 17, 2003

TM Official Gazette Date: _____

Atty. Docket No: 38644-175286

Re: Branstrom et al.

Application No: 08/711,961

Patent No: _____

Trademark: _____

Opposition/Cancellation No: _____

Filing Date: September 6, 1996

Issue Date: _____

Trademark Reg. No: _____

The following items were received from Venable, Washington, D.C., by the U.S. Patent & Trademark Office:

U.S. PTO FEES ENCLOSED

<input type="checkbox"/> Transmittal Letter	Filing Fee
<input type="checkbox"/> Fee Transmittal Letter	Surcharge Fee
<input type="checkbox"/> New U.S. Provisional Application (pages of specification/claims)	Additional Claim Fee
<input type="checkbox"/> Formal Drawings (sheets, Figs.)	Recordation/Indexing Fee
<input type="checkbox"/> Invention Declaration	IDS Fee
<input type="checkbox"/> U.S. National Stage Application of PCT Application	Extension Fee
<input type="checkbox"/> Translation of International Application	Notice of Appeal Fee
<input type="checkbox"/> New U.S. TM Application (specimens)	Brief on Appeal Fee
<input type="checkbox"/> Rule 53(d) Continued Prosecution Application	Oral Hearing Request Fee
<input type="checkbox"/> Substitute Specification	Petition Fee
<input type="checkbox"/> Rule 53(b) Continuation or Divisional Application (<i>attach copy of specification, claims, drawings & declaration</i>)	Issue Fee
<input type="checkbox"/> Priority Document-Cert. Copy of Appln.#: ; Country	Publication Fee
<input type="checkbox"/> Date Filed:	Maintenance Fee
<input type="checkbox"/> Request for Continued Examination (RCE) under 37 CFR 1.114	TM Statement of Use
<input type="checkbox"/> Request for Reconsideration	8 Affidavit Fee
<input type="checkbox"/> Application Data Sheet	8 and 15 Affidavit
<input type="checkbox"/> Assignment w/Cover Sheet	TM Renewal Application Fee
<input type="checkbox"/> IDS w/ PTO SB/08 a/k/a PTO Form-1449 (references)	Notice of Opposition Fee
<input type="checkbox"/> Response	TM Extension of Time Fee
<input type="checkbox"/> <input type="checkbox"/> Amendment/ <input type="checkbox"/> Preliminary Amendment	
<input type="checkbox"/> Petition/Request for Extension of Time (two mo. ext.)	
<input type="checkbox"/> Notice of Appeal	
<input type="checkbox"/> Appeal Brief (<i>In triplicate</i>)	
<input type="checkbox"/> Reply Brief (<i>In triplicate</i>)/ <input type="checkbox"/> Request for Oral Hearing	
<input type="checkbox"/> Confirmation of Hearing Petition	
<input type="checkbox"/> Issue Fee Transmittal and publication fee	
<input type="checkbox"/> Certificate of Correction	
<input type="checkbox"/> Maintenance Fee Transmittal	
<input type="checkbox"/> Power of Attorney	
<input type="checkbox"/> Response to Notice to File Missing Parts	
<input type="checkbox"/> Response to Notice to File Missing Requirements	
<input type="checkbox"/> Response to Restriction Requirement	
<input type="checkbox"/> Petition to Revive	
<input type="checkbox"/> Sequence Listing – CDR Enclosed? <input type="checkbox"/> Yes <input type="checkbox"/> No	
<input type="checkbox"/> Status Inquiry	
<input type="checkbox"/> Request for Non-Publication	
<input type="checkbox"/> Request to Rescind Non-Publication Request	
<input checked="" type="checkbox"/> Terminal Disclaimer	
<input type="checkbox"/> TM Statement of Use	
<input type="checkbox"/> Extension of Time (mo. ext.)	
<input type="checkbox"/> Declaration Under 8	
<input type="checkbox"/> Declaration Under 8 and 15	
<input type="checkbox"/> TM Renewal Application	
<input type="checkbox"/> Notice of Opposition (<i>Please list all documents in Other section</i>)	
<input type="checkbox"/> Amendment to Alleged Use	
<input type="checkbox"/> Other: (<i>Please describe below</i>)	

O I P E
OCT 17 2003
PATENT & TRADEMARK OFFICE

\$130.00 Total Fees Paid

Check Number Attached
Charge Deposit Account No. 22-0261*
 Yes No

*If the Deposit Account was used, was a copy of this form sent to Accounting?



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

BRANSTROM et al.

Appl. No. 08/711,961

Filed: September 6, 1996

For: BACTERIAL DELIVERY SYSTEM

Art Unit: 1636

Examiner: I. Yucel

Atty. Docket No. 38644-175286

Customer No.

26694

PATENT TRADEMARK OFFICE

SUBMISSION OF TERMINAL DISCLAIMER

U.S. Patent and Trademark Office
2011 South Clark Place
Customer Window
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

Sir:

Enclosed is a Terminal Disclaimer for the above-identified patent application.

Please charge the required fee and any other fee that may be necessary to Deposit
Account No. 22-0261.

Respectfully submitted,

Ann S. Hobbs, Ph.D.
Registration No. 36,830

VENABLE
P.O. Box 34385
Washington, D.C. 20043-9998
Telephone: (202) 962-4800
Telefax: (202) 962-8300

ASH/cc


**TERMINAL DISCLAIMER TO OBVIATE A DOUBLE PATENTING
REJECTION OVER A PRIOR PATENT**
Docket Number (Optional)
38644-175286

In re Application of: Arthur A. Branstrom et al.

Application No. 08/711,961

Filed: September 6, 1996

For: BACTERIAL DELIVERY SYSTEM

The owner*, Government of the United States, as represented by the Secretary of the Army of 100 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173, as presently shortened by any terminal disclaimer, of prior Patent No. 5,824,538. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of the prior patent, as presently shortened by any terminal disclaimer, in the event that it later expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims cancelled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

Check either box 1 or 2 below, if appropriate.

1. For submissions on behalf of an organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

2. The undersigned is an attorney of record.

Elizabeth Arwine 9/3/03
Signature Date

ELIZABETH ARWINE

Typed or printed name

Terminal disclaimer fee under 37 CFR 1.20(d) is included.

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

*Certification under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner). Form PTO/SB/96 may be used for making this certification. See MPEP § 324.

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/711,961	09/06/1996	ARTHUR A. BRANSTROM	003/030/SAP	9506

7590 03/01/2004

MCMR-JA (JOHN MORAN)
US ARMY MEDICAL RESEARCH
AND MATERIEL COMMAND
FORT DETRICK
FREDERICK, MD 217025012



EXAMINER
YUCEL, IREM

ART UNIT	PAPER NUMBER
1636	

DATE MAILED: 03/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

STAFF JUDGE ADVOCATE
FORT DETRICK, MD
2004 MAR - 3 AM 7:40

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 33



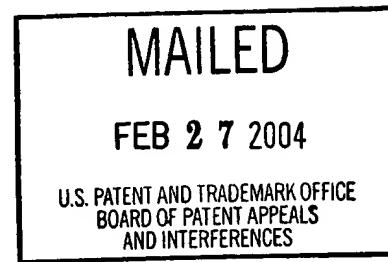
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ARTHUR A. BRANSTROM, DONATA R. SIZEMORE,
and JERALD C. SADOFF

Appeal No. 2001-1881
Application No. 08/711,961

ON BRIEF



Before WINTERS, ADAMS, and GREEN, Administrative Patent Judges.

GREEN, Administrative Patent Judge.

REQUEST FOR REHEARING

On December 22, 2003, this panel issued a decision on appeal in which we summarily affirmed the obviousness-type double patenting. In that decision, we noted:

Even though we now have new claims 56, 57, 59-62 and 64-65 before us, appellants do not dispute that the new claims are subject to the obviousness-type double patenting rejection affirmed in the May Decision on Appeal. Appellants' only remarks were that they would file a Terminal Disclaimer, which has not been filed at this time. See Paper No. 29. Under these facts, we summarily affirm the obviousness-type double patenting rejection as to newly entered claims 56, 57, 59-62 and 64-65.

Decision on Appeal mailed December 22, 2003, page 2.

In the Request for Reconsideration, Appellants request reconsideration of the above decision on the grounds that a terminal disclaimer was filed in the application on October 17, 2003. Appellants have also attached a copy of the Terminal Disclaimer to the Request for Reconsideration. The function of the Board in the ex parte context, however, is to review rejections. The Board does not perform examining functions in the first instance, and a terminal disclaimer must be proffered to the relevant Technology Center and the examiner, rather than to the Board. See MPEP § 1490.

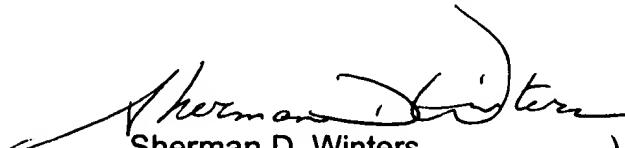
Moreover, an obviousness-type double patenting rejection of claim 45-55 was before us in the Decision on Appeal mailed May 30, 2003, and as appellants had not argued the merits of the rejection, and as a terminal disclaimer had not been filed, that rejection was also affirmed. The Request for Reconsideration does not provide an explanation as to why the terminal disclaimer filed October 17, 2003, after our first decision on appeal, was timely filed.¹ Accordingly, appellants request for rehearing is denied.

¹ See In re Deters, 515 F.2d 1152, 1157, 185 USPQ 644, 48 (CCPA 1975) ("Since no terminal disclaimer was timely filed, we sustain . . . [the obviousness-type double patenting] rejection."); Cf. In re Jursich, 410 F.2d 803, 807, 161 USPQ 675 (CCPA 1969), footnotes and citations omitted, ("The record shows that appellants' assignee filed a terminal disclaimer in the Patent Office after the board decision which the board refused to consider because it was not timely presented or considered by the examiner. Appellants assign error in that action by the board, arguing that the terminal disclaimer 'eliminated the double patenting issue in the present case.' However accurate that statement may be, we cannot consider the disclaimer here. . . .").

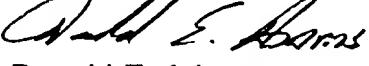
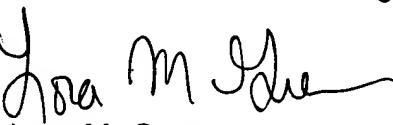
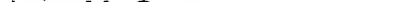
CONCLUSION

For the reasons set forth above, Appellant's Request for Rehearing is denied.

REQUEST FOR REHEARING-DENIED



Sherman D. Winters)
Administrative Patent Judge)


Donald E. Adams) BOARD OF PATENT
Administrative Patent Judge)
Lora M. Green) APPEALS AND
Administrative Patent Judge)
Lora M. Green) INTERFERENCES
Administrative Patent Judge)

MCMR-JA John Moran
US Army Medical Research
And Material Command
Fort Detrick
Frederick, Maryland 21702-5012